



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/607,913	06/30/2000	Eduardo Cue	P2514/001580-569	1176

7590 04/24/2003

James W Peterson
Burns Doane Swecker & Mathis L L P
P O Box 1404
Alexandria, VA 22313-1404

EXAMINER

RHODE JR, ROBERT E

ART UNIT	PAPER NUMBER
----------	--------------

3625

DATE MAILED: 04/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/607,913

Applicant(s)

CUE ET AL.

Examiner

Rob Rhode

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 March 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

The office action of 01/02/2003 rejected claims 1 - 44.

Applicant amendment of 03/27/2003 amended claims 1, 8, 15, 22, 29, 33, 37 and 41. Regarding claims 1 – 7 and 29 – 36, the applicant addressed the required corrections for the 35 USC 101 rejections and therefore the rejections have been overcome. Moreover, applicant traversed rejections of claims 1 – 44.

Currently, claims 1 - 44 are pending.

Response to Arguments

Applicant's arguments with respect to claims 1, 2, 5, 6, 8, 9, 12, 13, 15, 16, 18, 19, 22, 23 and 24 - 26 have been considered but are moot in view of the new ground(s) of rejection. With regard to applicants arguments regarding –

O claims 3, 4, 7, 10, 11, 14, 17, 20, 21, 27 and 28, applicant argues that the combination of eToys and Fortenberry does not disclose sending saved order data including order selections and purchase information to the recipient as described by amended independent claims 1, 8, 15 and 22. Further, the applicant argues Fortenberry does not disclose sending an electronic message to users where the message is generated by a first user and contains stored order purchasing information and stored order selection information. With regard to these arguments, eToys discloses the capability of sending an email to Grannies with a wish list and in this case interpreted as

Art Unit: 3625

an indication of an order for selected gifts. Additionally, while not disclosed by eToys, it was well known in the art at the time of the invention in ecommerce/shopping applications that URL's could be incorporated in an email in order to allow Grannies/shopper to link back to the eToys/first user site to purchase one or all of the preferred gifts selected. eToys certainly was not in the business to make it easy for Grannies to run out to ToyRus to purchase and thereby lose the business. Moreover, Fortenberry does disclose sending an electronic message to a set of select recipients (possible frequent shoppers or for use by eToys for the emails to Grannies) – determined by the first user where the message is generated by first user who in this reference is a merchant. In turn, the merchant/first user sends out the email flyers/solicitations with stored order data to recipients/Grannies, which provide the capability for the recipient to review and select directly from the email flyer/solicitation list of items/stored order - including quantities. Thus, the recipient can elect to purchase the stored order items directly from the email solicitation – by clicking on the choices desired or surf directly to the first users (merchants) web site to select these and/or other items for purchase. Thus, the teachings of eToys address the claims and the combination of eToys and Fortenberry provide the motivation for the capability to have provided the recipient the capability to order directly from the received email.

O claims 29 – 44, applicant argues that "Gift lists" does not disclose the type of information that is sent to users nor does "Gift list" disclose the ability to select multiple gifts. In addition, applicant argues that Della's does not disclose the content of the wish

Art Unit: 3625

list nor the recipient having the capability to receive and select multiple orders from the wish list. As evident in "Gift list" reference, the capability is fully disclosed in the article enabling an individual to develop and make available to others online - at a web site such as Della's, a list of preferred gifts for a specific occasion. With regard to multiple gifts, the fact that one makes a list is intuitively understood that it would contain multiple items/selections. Basically, most individuals develop a list in order to provide multiple choices to their friends and families so as to provide multiple selections - such as price range and therefore it is obvious that the capability of these "list's" described in the article would incorporate the ability to select multiple items for review by recipients. While "Gift list" does not disclose the capability to email these list, it does disclose the capability that once a recipient selects a gift from several choices contained in the list - an email is sent automatically to the first user notifying them that an individual has purchased an item/gift from their list. Moreover, the article does mention as one of the sites with this wish list capability - eToys. In that regard and as described, eToys in combination with Fortenberry does provide the capability to send email's from a first user to recipient(s) with the capability for the recipient(s) to select an item from the stored order as well as order from the e-mail's. Additionally and as fully disclosed by the Della.com web site screen shots, Della.com clearly has the capability for an individual to review and select more than one "item" on the "Your Wishlist" page. With regard to the content of the wish list, the screen capture of "Wishlist for Nicole Jones" fully discloses the ability to both develop a wish list and emailing the wish list to friends or family. On the other hand, Della.com does not disclose the capability for the recipient to order

directly from the received email. However and as previously described, Della.com in combination with eToys and Fortenberry would have incorporate the capability for the recipients to review and purchase directly from the email wish list of items. The teachings of Della.com address the details of the cited claims and the combination of Della.com with eToys/Fortenberry provide the motivation for the recipient to receive an email with stored order/items, review and to order directly from the received email.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1 - 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over “All to play in the US toy market: In less than two years eToys has gained a lead that would-be competitors will find hard to make up”; Financial Times; London; May 25, 1999; Tim Jackson (hereafter referred to as eToys) in view of Fortenberry (US 6,101,485).

Regarding Claim 1 and related Claims 8, 15 and 22, eToys teaches a method, computer readable medium, server system and apparatus for automatically sending an order from a first user to a recipient over a computer network, comprising – receiving order selections from a computer of the first user (Page 2, Para. 5). In addition and regarding, regarding Claim 5 and related Claims 12, 18 and 25, eToys teaches a method,

Art Unit: 3625

computer readable medium, server system and apparatus wherein the stored order includes a single item (Page 2, Para 15) and regarding Claim 6 and related Claims 13, 19 and 26, eToys teaches a method, computer readable medium, server system and apparatus wherein the stored order includes a main item and at least one accessory (Page 2, Para 15).

However, eToys does not specifically disclose saving stored order data, the stored order data including the order selections and order purchase information; and in response to a first user request, automatically producing and sending an electronic mail message concerning the stored order to a computer of the recipient, the electronic mail message identifying the stored order and order purchase information allowing the recipient to purchase the stored order using the stored order data and the order purchase information.

On the other hand, Fortenberry discloses and teaches saving stored order data, the stored order data including the order selections and order purchase information (Abstract, Col 1, lines 58 – 62 and Figure 2); and in response to a first user request, automatically producing and sending an electronic mail message concerning the stored order to a computer of the recipient, the electronic mail message identifying the stored order and order purchase information allowing the recipient to purchase the stored order using the stored order data and the order purchase information (Abstract and Col 1, lines 58 – 67 and Col 2, lines 1 – 6). Moreover:

regarding Claim 3 and related Claims 10, 17 and 24, Fortenberry teaches a method, computer readable medium, server system and apparatus wherein the display-producing step comprises producing a web page display of the stored order for purchase by the recipient (Abstract and Figure 1).

regarding Claim 4 and related Claims 11, 20 and 28, Fortenberry teaches a method, computer readable medium, server system and apparatus wherein the electronic mail message includes a URL which allows for the construction of a web page displaying the stored order (Col 2, lines 22 – 55).

regarding Claim 7 and related Claims 14, 21 and 27, Fortenberry teaches a method, computer readable medium, server system and apparatus wherein the step of receiving the order selections includes providing an electronic display of possible selections for the user (Abstract and Figure 1).

It would have been obvious to one of ordinary skill in that art at the time of the invention to have provided the method, computer readable medium, server system and apparatus of eToys with the method, computer readable medium, server system and apparatus of Fortenberry to enable for automatically sending an order from a first user to a recipient over a computer network, comprising – receiving order selections from a computer of the first user and saving stored order data, the stored order data including the order

selections and order purchase information; and in response to a first user request, automatically producing and sending an electronic mail message concerning the stored order to a computer of the recipient, the electronic mail message identifying the stored order and order purchase information allowing the recipient to purchase the stored order using the stored order data and the order purchase information – in order to provide a first user to send an order from their computer to the computer of a second user and allowing the second user to purchase the stored order. In that regard, the shopper can send the suggested order to another user with the full knowledge that not only will they feel better about providing a desired order and too will have the capability to order directly from the received order by activating a URL contained in the message. In this manner, the first and second users satisfaction will be increased, which will increase the probability that they both will return to the site in future as well as recommend the site to others.

Claims 29 – 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over eToys in view of Fortenberry (US Patent 6,101,485) and further in view of “Will Gift Lists Click?” New York Times; New York; Nov 18, 1999 and associated Waybackmachine screen captures of the Della.com web site content of March 4, 2000 (hereafter referred to as Della).

Regarding Claim 29 and related Claims 33, 37 and 41, the combination of eToys and Fortenberry disclose and teach to enable automatically sending an order from a first

user to a recipient over a computer network, comprising – receiving order selections from a computer of the first user and saving stored order data, the stored order data including the order selections and order purchase information; and in response to a first user request, automatically producing and sending an electronic mail message concerning the stored order to a computer of the recipient, the electronic mail message identifying the stored order and order purchase information allowing the recipient to purchase the stored order using the stored order data and the order purchase information.

On the other hand, the combination of eToys and Fortenberry does not disclose and teach a method, computer readable medium, server system and apparatus for storing order selections on a computer network, comprising - receiving first order selections from a computer of the first user, the order selections including at least one main item and at least one accessory for the main item; saving first stored order data, the first stored order data including the first order selections and first order purchase information; receiving second order selections from the computer of the first user; saving second stored order data, the second stored order data including the second order selections and second order purchase information; and thereafter, in response to a request from the first user, providing a display of the unpurchased first and second stored orders the display allowing the user to select the first or the second order for review.

Art Unit: 3625

However, regarding Claim 29 and related Claims 33, 37 and 41, Della teaches a method, computer readable medium, server system and apparatus for storing order selections on a computer network, comprising - receiving first order selections from a computer of the first user, the order selections including at least one main item and at least one accessory for the main item (Page 5); saving first stored order data, the first stored order data including the first order selections and first order purchase information (Page 5); receiving second order selections from the computer of the first user (Page 5); saving second stored order data, the second stored order data including the second order selections and second order purchase information; and thereafter, in response to a request from the first user, providing a display of the unpurchased first and second stored orders the display allowing the user to select the first or the second order for review (Page 5).

Regarding Claim 30 and related Claims 34, 38 and 42, Della teaches a method, computer readable medium, server system and apparatus wherein the first and second order selections are selected from a web page from an electronic commerce site (Page 2, Para 5 and Page 5).

Regarding Claim 31 and related claims 39 and 43, Della teaches a method, computer readable medium, server system and apparatus wherein the display of the first or second order is a web page display (Page 5).

Art Unit: 3625

Regarding Claim 32 and related Claims 36, 40 and 44, Della teaches a method, computer readable medium, server system and apparatus wherein the display of the first or second orders includes a link to a display of the items of the first order and a display of the items of the second order (Page 5).

Regarding Claim 35, Della teaches a method, computer readable medium, server system and apparatus, wherein the display of the first and second orders comprises a web page (Page 5).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided the combination of eToys and Fortenberry with the method, computer readable medium, server system and apparatus of Della to enable storing order selections on a computer network, comprising - receiving first order selections from a computer of the first user, the order selections including at least one main item and at least one accessory for the main item; saving first stored order data, the first stored order data including the first order selections and first order purchase information; receiving second order selections from the computer of the first user; saving second stored order data, the second stored order data including the second order selections and second order purchase information; and thereafter, in response to a request from the first user, providing a display of the unpurchased first and second stored orders the display allowing the user to select the first or the second order for review – in order to provide the user with capability to review the current lists of desired products as

Art Unit: 3625

potential gifts, add or delete as necessary and also serves as a reason for the user to return to the electronic commerce site more often as well as increasing the probability of another purchase. In this regard, the recipient as well as the first user's satisfaction will be increased and thereby increase the probability that they will return to the site for additional shopping as well as recommend the site to others.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rob Rhode whose telephone number is 703.305.8230. The examiner can normally be reached on M-F 7:30am - 4:00pm.

Art Unit: 3625

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 703.308.1344. The fax phone numbers for the organization where this application or proceeding is assigned are 703.305.7658 for regular communications and 703.308.3687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703.306.1113.

RER
April 15, 2003


WYNN W. COGGINS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600